

REMARKS

This is a complete response to the outstanding Office Action mailed September 20, 2006. Claims 19 and 28 have been amended herein. Support for amended claims 19 and 28 may be found in, for example, original claim 16, Figures 1, and original specification paragraphs [0015] and [0018]. No new matter has been added. Upon entry of the enclosed claim amendments, claims 1-28 remain pending in the present application.

I. Response to Claim Objections and Rejection -35 USC § 112

A. Claim 1, 19, and 28

Applicant appreciates the Examiner's comprehensive review of the claims. Applicant respectfully requests reconsideration and withdrawal of the claim objections. The term "substantially" is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. In re Nehrenberg, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). The court held that the limitation "to substantially increase the efficiency of the compound as a copper extractant" was definite in view of the general guidelines contained in the specification. In re Mattison, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court

held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in the art would know what was meant by "substantially equal." Andrew Corp. v. Gabriel Electronics, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988).

Applicant specification does provide general guidelines contained in the specification. For example, the specification, in paragraph [0026] and [0027], describes an overlay strategy which allows the broadcast signal in the background layer 50 to be visible through the second layer 54. The second layer utilizes a substantially transparent background 56. As shown in Figures 4 and 5, the substantially transparent background 56 allows the background layer 54 to be displayed in the combine image shown in Figure 5. One skilled in the art would understand what was meant by "a substantially transparent background" in view of the specification examples and graphics. The Office Action has provided no support as to why an individual skilled in the art based on the above-cited proportion of the specification would not provide guidelines to one skilled in the art. Therefore the rejection of claims 1, 19 and 28 should be withdrawn.

B. Claim 1-28

Applicant respectfully requests withdrawal of the claim objections 1-28 based on the above argument with regard to claims 1, 19, and 28.

II. Response to Claim Rejections Based on Obviousness

In the Office Action, claims 1-7, 11-14, 19-22, 27, and 28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Newswire (article entitled, NBC to Broadcast Interactive Fall 1997-98 Programming Enhanced with Wink ITV™, published June 30, 1997). Hereinafter referred to as Newswire in view of obviousness. Applicant respectfully traverses this rejection.

A. Claim 1

The Applicant respectfully submits that Newswire fails to disclose, teach, or suggest all elements of the rejected claim for at least the reasons that follow. Newswire does not teach or disclose an overlay layer having a substantially transparent background. The Office Action provides a motivation for obviousness on the grounds that a transparent layer of enhancing the TV programming because it would provide users with supplemental information relating to the TV broadcasts being

watched by the user, which makes it fun and attractive without interfering with the experience.

However, this does not provide a specific teaching or motivation for a transparent layer. This may arguable provide a teaching for mixing video content but does not disclose, teach or suggest why one skilled in the art at the time of the invention would use an overlay having a substantially transparent background. Newswire and the prior cited motivation suggests adding content without interfering with programming content, which would provide a motivation for splitting, reduce, or modify programming to mix content so as not to overlap and obstruct programming. While Newswire does describe the end result to the viewer as viewable atop the TV broadcast, Newswire is silent as to the specific mechanics used to combine content.

The Federal Circuit has also repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). The black letter law statements by Judge Linn in *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) address this subject, viz:

a) Hindsight

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect taught is used against the teacher." (*Id.* At 1369, 55 USPQ2d at 1316) (citations omitted).

b) Need for Motivation

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. (*Id.* at 1369, 55 USPQ2d at 1316).

(c) Particular Findings Required

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved, as a whole would have suggested to those of ordinary skill in the art. Whether the Board relies on an express or an implicit

showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not "evidence." (*Id.* at 1370, 55 USPQ2d 1317) (citations omitted).

The Office has not provided any evidence as to why one skilled in the art at the time of the invention would use an overlay layer having a substantially transparent background in place of traditional video mixing technology. The Office must provide a rejection guided only by the prior art references and the then-accepted wisdom in the field without relaying on Applicant's disclosure as a blueprint. The rejection should identify the teachings and separately identify the motivation for combining the teachings so as to prevent broad conclusory statements. The rejection of Newswire in view of obviousness should be withdrawn and claim 1 should be allowed for at least the above reasons.

The Applicant also respectfully submits that since claims 2-18 depend on independent claim 1, claims 2-18 contain all limitations of independent claim 1. Since independent claim 1 should be allowed, as argued herein, pending dependent claims 2-18 should be allowed as a matter of law for at least this reason. In re Fine, 5 U.S.P.Q.2d 1596, 1608 (Fed. Cir. 1988).

B. Claim 19

The Applicant respectfully submits that Newswire fails to disclose, teach, or suggest all elements of the rejected claim for at least the reasons that follow. Newswire does not disclose, teach, or suggest transmitting said broadcast presentation to said plurality of viewers from a source separate and independent of the computer network transmitting the overlay layer. Therefore, for at least these reasons claim 19 overcomes the above 103 rejection.

The Applicant also respectfully submits that since claims 20-27 depend on independent claim 19, claims 20-27 contain all limitations of independent claim 19. Since independent claim 19 should be allowed, as argued herein, pending dependent claims 20-27 should be allowed as a matter of law for at least this reason.

In re Fine, 5 U.S.P.Q.2d 1596, 1608 (Fed. Cir. 1988).

C. Claim 28

Amended independent claim 28 reads:

"...wherein said plurality of multi-media tools comprises a broadcast mute tool to **dampen said broadcast presentation** on each said viewer display device allowing said at least one overlay to be emphasized."

(Emphasis Added)

The Applicant respectfully submits that Newswire fails to disclose, teach, or suggest all elements of the rejected claim for at least the reasons that follow. Newswire does not teach or disclose a broadcast mute tool to dampen said broadcast presentation. Mitchell et al. (US6,175,343) does not cure the above defect. Mitchell nor Newswire disclose dampening said an overlay to allow one overlay to be emphasized.

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d. 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). The black letter law statements by Judge Linn in *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000). No disclosure, teaching, or suggestion is provided by either Newswire or Mitchell for diminishing the broadcast of one layer. The Examination simply fabricated this teaching in order to reconstruct Applicant invention of claim 16. Therefore, the rejection of Newswire in view of Mitchell should not be applied to amended claim 28.

III. Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.


CONCLUSION

In light of the foregoing amendments and comments and for at least the reasons set forth above, Applicant respectfully submits that all objections and rejections have been traversed, rendered moot and/or accommodated, and that presently pending claims 1-28 are in condition for allowance. Applicant has responded to all of the Examiner's requests. Favorable reconsideration and allowance of the present application and the presently pending claims are hereby courteously requested. The examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

Respectfully submitted,

Eric Beckman, et al.

By



Andrew R. Martin
Registration No. 45,413

In re: Eric Beckman, et al.
Filed: October 19, 2001
Serial No.: 10/036,329
Page 20

Attorney for Applicant(s)

BOURQUE & ASSOCIATES, P.A.
835 Hanover Street, Suite 301
Manchester, New Hampshire 03104

Telephone: (603) 623-5111
Facsimile: (603) 624-1432

Date: 3-20-07